

REMARKS

I. Introduction

Claims **1-36** and **38-54** are currently pending in the present application. Claims **3**, **8**, and **10-12** have been withdrawn from consideration, leaving claims **1-2**, **4-7**, **9**, **13-36**, and **38-54** remaining for consideration. Of the claims remaining for consideration, claims **1**, **33**, **36**, and **38-40** are independent.

In the Non-Final Office Action mailed on January 11, 2007 as Part of Paper No./Mail Date 20070109 (hereinafter the “Office Action”), the Examiner imposes a Restriction Requirement. In particular, the Examiner states:

This application contains claims directed to the following patentably distinct species of the claimed invention: **Species I**, *arranging a benefit to be applied to the transaction in exchange for a future performance of a task by the customer* as described in **claims 1, 2, 4-7, 9, 13-36, 38 and 39**; and **Species II**, *a menu listing a plurality of benefits available for application to the transaction* as described in **Claims 40-54**.

(Office Action, pg. 2, first paragraph; all emphasis added).

Applicants provisionally elect to prosecute “Species I” (including claims **1**, **2**, **4-7**, **9**, **13-36**, **38** and **39**). This provisional election is made with traverse. That is, Applicants respectfully disagree with the Examiner's proposed restriction. Applicants request reconsideration of the restriction requirement in light of the following arguments, and pursuant to 37 C.F.R. §1.143.

II. The Examiner has Failed to Establish a *Prima Facie* Case for Restriction

Restriction of the pending claims is not believed to be appropriate in this case. Specifically, Applicants respectfully submit that the Examiner has **entirely** failed to establish a *prima facie* case for restriction.

A. Proper Basis for Restriction

1. Generally

Restriction is proper only where an application contains claims directed to two or more independent or distinct inventions. MPEP §802.01. The term "independent" is defined as meaning "that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect". MPEP §802.01. To establish a *prima facie* case for restriction where the basis for restriction is that the different inventions being claimed are "independent", the Examiner must demonstrate "the reasons...why the inventions as claimed are...independent". MPEP §808. The term "distinct", as used in restriction practice, means that two or more claimed subjects are "(1) capable of separate manufacture, use or sale; and (2) are patentable over each other". *Id.* To establish a *prima facie* case for restriction where the basis for restriction is that the inventions are "distinct", the Examiner must establish (1) "the reasons (as distinguished from the mere statement of conclusion) why the inventions *as claimed* are...distinct", and (2) "the reasons for insisting upon restriction therebetween". MPEP §808.

2. The Examiner's Case as Set Forth

The Examiner utterly fails to set forth *any* reasoning, arguments, or evidence regarding why restriction is believed to be appropriate in this case.

Accordingly, the Examiner fails to satisfy the burden of establishing a *prima facie* case for restriction under MPEP §808, for either "independent" or "distinct"-based restrictions.

B. A *Prima Facie* Case for "Distinct" Restriction has not been Established

No reasons for believing the claimed inventions are "distinct" have been set forth, nor has the second requirement of presenting reasons for insisting upon restriction been complied with. The Examiner has failed to show that (1) that each claimed invention "has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search", (2) that even if classified together they have formed separate

subjects for inventive effort, or (3) that a different field of search is required. MPEP §808.02. Absent such showings as required by MPEP §808.02, no *prima facie* case for restriction under the "distinct" theory is established. Where "the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions." *Id.*

C. The Examiner has Failed to Establish an Undue Burden

Even if a *prima facie* case for restriction establishes that an application includes independent or distinct inventions, restriction is not proper "[i]f the search and examination of [the] entire application can be made without serious burden." MPEP §803. Applicants respectfully assert that restriction is not proper in this case because there is no indication that any serious burden exists. In particular, (1) there is no separate classification of the alleged Species which would necessitate a separate field of search; (2) the alleged Species can be searched using the same field of search without unduly burdening the Examiner; and (3) the alleged Species are not related to any class of invention which has achieved a separate status in the art. See, MPEP §808.02.

In general, Applicants believe that the claims all can readily be searched and examined together without undue burden on the Examiner. Thus, even if the Examiner had set forth a *prima facie* case for restriction and had relied upon proper grounds for restriction, restriction would still not be proper in this case.

III. Conclusion

At least for the foregoing reasons, Applicants respectfully request that the restriction requirement be withdrawn upon reconsideration.

Alternatively, if there remain any questions regarding the present application or the cited reference, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Carson C.K. Fincham at telephone number 203-461-7017 or via electronic mail at cfincham@walkerdigital.com, at the Examiner's convenience.

IV. Petition for Extension of Time to Respond

While no fees are believed to be due at this time, please charge any fees that may be required for this Amendment to Deposit Account No. 50-0271. Furthermore, should an extension of time be required, please grant any extension of time which may be required to make this Amendment timely, and please charge any fee for such an extension to Deposit Account No. 50-0271.

Respectfully submitted,

February 8, 2007
Date

/Carson C.K. Fincham, Reg.#54096/
Carson C.K. Fincham
Attorney for Applicants
Registration No. 54,096
Walker Digital, LLC
cfincham@walkerdigital.com
203-461-7017 /voice
203-461-7300 /fax